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| 10/719,867  | 11/21/2003  | Andrew James Thomas  | 920476-95145        | 2920             |
| 31292 7590 07/08/2009<br>CHRISTOPHER & WEISBERG, P.A.<br>200 EAST LAS OLAS BOULEVARD<br>SUITE 2040<br>FORT LAUDERDALE, FL 33301 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| WINTER, JOHN M  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/719,867

**Applicant(s)**

THOMAS ET AL.

**Examiner**

JOHN M. WINTER

**Art Unit**

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 20, 21 and 28-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 20-21 and 28-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, 20- 21 and 28-32 are drawn to a program controller, classified in class 700 subclass 1.
  - II. Claims 15-19 is drawn to licensed usage of content, classified in class 705 subclass 59.
  - III. Claim 22-26 are drawn to authorized user, classified in class 726 subclass 1.
  - IV. Claim 27 is drawn to billing software, classified in class 705 subclass 34.
- 
2. Inventions I, II ,III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, inventions I-IV each have a separate utility such as a license (II), user authorization (III) and billing software (IV) the combination as claimed in invention I does not require the particulars of the subcombination as claimed in invention II-IV such as a benefit.
  3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Examiner notes that it would be a burden to search multiple inventions given their separate status in the art as noted above.
5. The requirement is deemed proper and therefore made FINAL.
6. Via paper filed on April 4, 2009 a provisional election was made without traverse to prosecute the of Invention I, claims 1-14, 20- 21 and 28-32. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-19, and 22-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
7. Claims 1-14, 20-21 and 28-33 have been examined.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-14, 20-21 and 28-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
9. Claims 1-14, 20-21, 29 and 31-33 are “software per se” the claimed “structure” of the invention is composed entirely of software (e.g. controller, interface) and as such is non-statutory.
10. Examiner notes that Applicant states “the program controller being in the form of software” at page 11, line 23 of the specification filed on November 11, 2003.

11. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. (MPEP 2106.01 –FUNCTIONAL DESCRIPTIVE MATERIAL: “DATA STRUCTURES ”)

12. Claim 28 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

13. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

14. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively

or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

15. In this particular case, claim 28 fails prong (1) because the "tie" (e.g. a hardware module ) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.
16. Claim 30 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.
17. An electromagnetic data signal is non-statutory subject matter. *In re Nuijten*, 500 F.3d 1346 (Fed. Cir. 2007).

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

18. Claims 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
19. Claims 10 and 11 are indefinite because they are a hybrid claims. In particular, the claim 1 appears to be directed to neither a "process" nor a "machine," but rather embraces

or overlaps two different statutory classes of invention. Evidence to support an interpretation that claims 10 and 11 are a *product* is (1) the preamble which states "A program controller" and (2) the body of the claim which recites "a modular system."

Alternatively, evidence that indicates the claim is directed to a *process* or method is the body of the claim which recites "copying all of part of the program (authorizing in the instance of claim 11)" Because of this conflicting evidence, it is unclear if claim 1 is a product or process claim. See the 35 U.S.C. § 101 rejection above. See MPEP § 2173.05(p) II or Ex Parte Lyell, 17 USPQ2d 1548 (B.P.A.I. 1990). For prior art purposes, the Examiner interprets the claim as being drawn to a product claim.

20. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, there is insufficient antecedent basis for the claimed term "the module"
- Claims 31 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. These claims are omnibus type claims.
21. Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, this claim fails to further limit the scope of the invention.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

22. Claims 1-14,20-21 and 28-33 are rejected under 35 U.S.C. 102(b) as being unpatentable over Katz et al (US Patent 5,926,624).

23. As per claim 1,

Katz ('624) discloses a program controller arranged for use with a modular system, and arranged to manage a program for use with a replaceable hardware module of the modular system, the module being a customer-replaceable part, the controller being arranged to manage the program automatically,(Column 11, lines 1-31) according to an agreement between a supplier and a customer,(Abstract) and according to a stored history of use of the hardware module. (Column 8, lines 19-27)

Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).The claimed features of "arranged to manage" etc.. fails to limit the claimed invention.

24. As per claim 2,

Katz ('624) discloses the program of claim 1,  
the history being stored on the module. (Column 8, lines 19-27)



25. As per claim 3,

Katz ('624) discloses the program controller of claim 1 arranged to be part of a shelf controller for managing modules in the form of cards for carrying out functions of a network element for a telecommunications network.(Figure 4) Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

26. As per claim 4,

Katz ('624) discloses the program controller of claim 1 the program controller being arranged to determine an identity of the system and check it is authorized for use with that system. (Column 14, line 28; discussion of “digital signature protocol”) Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

27. As per claim 5,

Katz ('624) discloses the program controller of claim 1

the history comprising a program identifier of a program previously loaded on the module.  
(Column 8, lines 19-27)

28. As per claim 6,

Katz ('624) discloses the program controller of claim 1  
the history comprising a licence identifier of a program previously loaded on the module.  
(Column 8, lines 19-27)

29. As per claim 7,

Katz ('624) discloses the program controller of claim 1  
arranged to be located remotely from the system, and coupled to the system by a  
communications link.(Figure 4)

Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

30. As per claim 8,

Katz discloses the program controller of claim 1, arranged to maintain an inventory record of identities and relationships of modules, programs, and licence information for a given customer. (Column 14, line 28; discussion of "digital signature protocol")  
Examiner notes that while features of an apparatus may be recited either structurally or

functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

31. As per claim 9,

Katz ('624) discloses the program controller of claim 1 arranged to determine any changes in modules, at initialization, and to check the configuration of any newly coupled modules. (Column 14, line 28; discussion of "digital signature protocol") Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

As per claim 10,

32. Katz ('624) discloses the program controller of claim 1 the managing comprising copying all or part of the program to the module at initialization. (Column 14, line 28; discussion of "digital signature protocol")

33. As per claim 11,

Katz ('624) discloses the program controller of claim 1

the managing comprising authorizing all or part of the program for the module at initialization. (Column 15, line 63 – column 17, line 24)

34. As per claim 12,

Katz ('624) discloses the program controller of claim 1  
the history comprising an indication of which systems the module has been coupled to.  
(Column 14, line 28; discussion of “digital signature protocol”)

35. As per claim 13,

Katz ('624) discloses the program controller of claim 1  
the program having license information indicating a capability licensed, the program controller being arranged to configure the program according to the capability licensed.  
(Column 14, line 28; discussion of “digital signature protocol”)

Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

36. As per claim 14,

Katz ('624) discloses the program controller of claim 1

the program having license information indicating license expiry information. (Column 14, line 28; discussion of “digital signature protocol”)

37. As per claim 21,

Katz ('624) discloses the program controller of claim 20 having an interface for coupling to a remote server to pass information for a supplier to maintain an inventory of programs and modules.(Figure 4) Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

Claims 28-33 are in parallel with the above rejected claims and are rejected for at least the same reasons.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685